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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,802	09/08/2003	Larry C. Satek	I3002.0015.NPUS00 USMA:01	1167
24628	7590	12/29/2004	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			DANG, THUAN D	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	10/657,802	SATEK ET AL.
	Examiner	Art Unit
	Thuan D. Dang	1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) 12 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/8/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: there are a lots of mistyped words in the specification such as page 5, lines 1 and 33, page 6, line 1.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because there are a lots of misspelled words in the specification and claims.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

The abstract of the disclosure is objected to because there is misspelled word in the heading. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 12 is objected to because of the following informalities: there are misspelled words in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koichi (the **English abstract of JP3024021**) in view of Zuech (3,849,507).

Koichi discloses a process of alkylation of m-xylene with iso-butylene to produce 5-tert-butyl-metaxylene in the presence of an activated clay catalyst (see the abstract).

As defined by applicants on page 3, lines 10-17, the “active clay” used in the claimed process is a clay having been treated with an acid such as sulfuric acid, hydrochloric and phosphoric acid.

As in the English abstract of JP3024021, Koichi is silent as to such an acid-treated catalyst. However, Zuech discloses using an acid-activated clay such as montmorillonite for alkylation an aromatic hydrocarbon such as meta-xylene with an olefin such as isobutylene (the abstract; col. 2, lines 10-30; col. 3, lines 46 and 60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Koichi process by using the Zuech active clay catalyst to arrive at the claimed process since as disclosed by Zuech, his catalyst will result in unusually high yields of alkylated aromatic hydrocarbons.

The temperature of the process can be found in both references (Zuech: col. 3, lines 68-73.

The pressure of the process can be found on column 3, lines 68-75 of Zuech. Note that the abstract of the JP3024021 the pressure can be under a low pressure of ordinary pressure to

several kg/cm². Therefore, the range of pressure used in Koichi process must cover the pressure recited in claim 11 and 15.

On column 4, lines 18-23, Zuech discloses the recycle of aromatic hydrocarbon after the desired alkylated product is obtained.

Neither Zuech nor Koichi disclose how the catalyst is treated – removal, recovered and recycle – after the reaction. However, the removal of the catalyst for regeneration and reuse depends on the activity during the process. Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Koichi process having been modified by Zuech's teachings by selecting the timing for removing of the catalyst, regeneration, and reuse when the catalyst become inactive.

The concentration of participating reactants and catalysts are parameters of a chemical process obvious to be selected to optimize the process since it has been held by the patent law that the selection of reaction parameters such as temperature and concentration would have been obvious. More particularly, where the general conditions of the claimed are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller* 105 USPQ 233, 255 (CCPA 1955). *In re Waite* 77 USPQ 586 (CCPA 1948). *In re Scherl* 70 USPQ 204 (CCPA 1946). *In re Irmscher* 66 USPQ 314 (CCPA 1945). *In re Norman* 66 USPQ 308 (CCPA 1945). *In re Swenson* 56 USPQ 372 (CCPA 1942). *In re Sola* 25 USPQ 433 (CCPA 1935). *In re Dreyfus* 24 USPQ 52 (CCPA 1934).

As known, montmorillonite is a dioctahedral smectite.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Powell (6,271,298) discloses on column 1, lines 15-20 that montmorillonite is a dioctahedral smectite.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan D. Dang whose telephone number is 571-272-1445. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thuan D. Dang
Primary Examiner
Art Unit 1764

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